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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,872	07/30/2003	Hyun-Ah Sung	Q76120	7359

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EXAMINER
HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/629,872	SUNG ET AL.
	Examiner	Art Unit	
	Cong-Lac Huynh	2178	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 March 2006</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-33</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☐ Claim(s) <u>1-12, 14-15, 17-28, 30-31, 33</u> is/are rejected.
7)☒ Claim(s) <u>13,16,29 and 32</u> is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: response filed 3/9/06 to the

application filed on 7/30/03, priority filed 12/2/02.

2.   Claims 1-33 are pending in the case. Claims 1, 7, 17 and 23 are independent

claims.

3.   The rejections of claims 1-4, 17-20, 33 under 35 U.S.C. 102(e) as being

anticipated by Pennell have been withdrawn in view of Applicants arguments.

4.   Claims 5-6, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Pennell et al. (US Pat App Pub No 2005//0149854, 7/7/05, filed 2/11/05, priority

11/9/99).

5.   Claims 7-12, 14-15, 23-28, 30-31 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pennell et al. (US Pat App Pub No 2005//0149854, 7/7/05, filed ·

2/11/05, priority 11/9/99) in view of Winkler (US Pat App Pub No 2002/0137507,

9/26/02, filed 3/20/01).

Priority

6.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which

papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

9.   Claims 1-6, 17-22, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Pennell et al. (US Pat App Pub No 2005//0149854, 7/7/05, filed 2/11/05, priority

11/9/99) in view of Gonzales (US Pat App Pub No 2002/0161603, filed 4/16/02).

Regarding independent claim 17, Pennell discloses:

-   detecting a floating field of a template document, which is an incomplete

    document having a fixed field in addition to the floating field, by parsing a control

    document including information identifying the floating field and a list of

    selectable objects (figures 4 and 5: verifying information in document 401, which

    is equivalent to a control document, in figure 5 before filling the information into

    the form 100 in figure 4, which is equivalent to the template document, where the

data in the fields with pull down lists implies parsing document 401for selecting

data in the pull down lists with selectable elements to fill in the form 100)

- rendering and outputting the control document (figure 4: document 401 is

  displayed)

- receiving information selected by a user with respect to the output control

  document (figure 4: user can select Filling button or Cancel button when

  document 401 is displayed)

- completing the template document as a document by fixing the detect floating

  field to be an object designated by the information selected by the user among

  the list of selectable objects, when the information selected by the user is

  received by the user is received in the receiving step (figure 7: complete the

  template document 100 by selecting one of the data in the pull down lists to fill in

  the template document)

Pennell does not disclose that the document to be processed is a multimedia document.

Gonzales discloses a template with fields for entering data where the data includes text

and image (figures 6, 10, [0181]).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Gonzales into Pennell since Gonzales teaches creating a

multimedia document via entering text and images into fields of a template providing the

advantage to incorporate into Pennell for entering image data in a form filled with text.

The combination of Gonzales into Pennell would expand the types of data for entering

in a form field, where the data can be images instead of only text as usual, and for

creating a document, which can be a multimedia document which includes text and images.

Regarding claim 18, which is dependent on claim 17, Pennell discloses rendering and outputting the template document before rendering and outputting the control document (figure 4).

Regarding claim 19, which is dependent on claim 17, Pennell discloses that the fixed field, which includes information on a document structure and at least one default multimedia file, cannot be selected by the user, and the floating field, which includes multimedia file information on at least one multimedia file, can be selected by the user (figure 5: fields without a pull down list have default data, and fields with a pull down list can be selected by a user).

Regarding claim 20, which is dependent on claim 19, Pennell discloses receiving user construction information from the user when the information selected by the user is received in the receiving step and the multimedia file information designated by the information selected by the user is the user construction information before the step of completing the template document (figure 5: selecting Filling button shows the data designated in the form is selected by the user as the user construction information before filling the data into the template document).

Claims 1-4 are for an apparatus for performing method claims 17-20, and are rejected under the same rationale.

Claim 33 is for a computer readable medium for performing method claim 17, and is rejected under the same rationale.

Regarding claims 21 and 22, which are dependent on claims 19 and 21 respectively, Pennell discloses that the form 100 for populating data, which is equivalent to a template document, and the data document 401, which is equivalent to a control document, are constructed in XML or HTML with scripts for displaying data in the pop up window including data in the pull down list as well as populating data in the pop up window into the form in the website ([0026]-[0028]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Pennell to include the identification codes of the predetermined elements and the list of values of predetermined attributes of the predetermined elements for the following reason. Pennell discloses using scripts for displaying data in the pop up window including data in the pull down list. This suggests that the elements in the pull down list are predetermined elements and the scripts have codes for performing said predetermined elements in the pull down list where these elements have associated attributes related to the fields they belong to such as name, address, or phone number with specific formats.

Pennell does not disclose that if the template document is constructed in SIML, the document structure includes one or more predetermined elements and one or more predetermined attributes of the predetermined elements and the multimedia file information includes one or more identification codes of the predetermined elements and one or more values of the predetermined attributes.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Pennell to incorporate SIML for constructing the template document since using XML for constructing the form 401, which is equivalent to the template document, motivates using SIML for constructing the template document since SIML is an expanded form of XML.

Claims 5-6 are for an apparatus for performing method claims 21-22, and are rejected under the same rationale.

10.   Claims 7-12, 14-15, 23-28, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell et al. (US Pat App Pub No 2005//0149854, 7/7/05, filed 2/11/05, priority 11/9/99) in view of Gonzales (US Pat App Pub No 2002/0161603, filed 4/16/02) and Winkler (US Pat App Pub No 2002/0137507, 9/26/02, filed 3/20/01).

Regarding independent claim 23, Pennell discloses:
  - detecting a floating field of a template document, which is an incomplete document having a fixed field in addition to the floating field, by parsing a control

document including information identifying the floating field and a list of

selectable objects (figures 4 and 5: verifying information in document 401, which

is equivalent to a control document, in figure 5 before filling the information into

the form 100 in figure 4, which is equivalent to the template document, where the

data in the fields with pull down lists shows that said fields are floating fields with

selectable objects since data can be selected from the pull down lists to fill in the

form 100)

- rendering and outputting the control document (figure 4: document 401 is

displayed)

- receiving information selected by a user with respect to the output control

document (figure 4: user can select Filling button or Cancel button when

document 401 is displayed)

- completing the template document as a document by fixing the detect floating

field to be an object designated by the information selected by the user among

the list of selectable objects, when the information selected by the user is

received by the user is received in the receiving step (figure 7: complete the

template document 100 by selecting one of the data in the pull down lists to fill in

the template document)

Pennell does not disclose that the document to be processed is a multimedia document.

Gonzales discloses a template with fields for entering data where the data includes text

and image (figures 6, 10, [0181]).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Gonzales into Pennell since Gonzales teaches creating a

multimedia document via entering text and images into fields of a template providing the

advantage to incorporate into Pennell for entering image data in a form filled with text.

The combination of Gonzales into Pennell would expand the types of data for entering

in a form field, where the data can be images instead of only text as usual, and for

creating a document, which can be a multimedia document with text and images.

Pennell also does not disclose:

- rendering and outputting the completed message when a preview function is

  selected by the user

- transmitting the output message to a terminal having a reception number when

  the user selects the output multimedia message and inputs the reception number

Winkler discloses:

- rendering and outputting the completed multimedia message when a preview

  function is selected by the user ([0020]: the multimedia message is outputted to

  the user for previewing where the preview feature was a well known option for

  reviewing a generated document before further processing the document such as

  printing or transmitting)

- transmitting the output multimedia message to a terminal having a reception

  number when the user selects the output multimedia message and inputs the

  reception number ([0020]: transmitting the multimedia message to a target

  destination where in order to send a message, the address of the destination,

which is equivalent to the reception number of the target terminal, should be

provided by a user)

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Winkler into Pennell and Gonzales since Winkler teaches

rendering the multimedia message to user for previewing and transmitting the output

multimedia message to a terminal having a reception number providing the advantage

to incorporate into Pennell and Gonzales for easily preventing and fixing errors if any

before transmitting the multimedia message to a target terminal.

Regarding claim 24, which is dependent on claim 23, Pennell discloses rendering and

outputting the template document before rendering and outputting the control document

(figure 4).

Regarding claim 25, which is dependent on claim 23, Pennell discloses that the fixed

field, which includes information on a document structure and at least one default

multimedia file, cannot be selected by the user, and the floating field, which includes

multimedia file information on at least one multimedia file, can be selected by the user

(figure 5: fields without a pull down list have default data, and fields with a pull down list

can be selected by a user).

Regarding claim 26, which is dependent on claim 25, Pennell discloses receiving user

construction information from the user when the information selected by the user is

received in the receiving step and the multimedia file information designated by the

information selected by the user is the user construction information before the step of

completing the template document (figure 5: selecting Filling button shows the data

designated in the form is selected by the user as the user construction information

before filling the data into the template document).

Regarding claims 28 and 31, which are dependent on claims 27 and 30 respectively,

Pennell discloses that the form 100 for populating data, which is equivalent to a

template document, and the data document 401, which is equivalent to a control

document, are constructed in XML or HTML with scripts for displaying data in the pop

up window including data in the pull down list as well as populating data in the pop up

window into the form in the website ([0026]-[0028]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have modified Pennell to include the identification codes of the

predetermined elements and the list of values of predetermined attributes of the

predetermined elements for the following reason. Pennell discloses using scripts for

displaying data in the pop up window including data in the pull down list. This suggests

that the elements in the pull down list are predetermined elements and the scripts have

codes for performing said predetermined elements in the pull down list where these

elements have associated attributes related to the fields they belong to such as name,

address, or phone number with specific formats.

Pennell does not disclose that if the template document is constructed in SIML, the document structure includes one or more predetermined elements and one or more predetermined attributes of the predetermined elements and the multimedia file information includes one or more identification codes of the predetermined elements and one or more values of the predetermined attributes.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Pennell to incorporate SIML for constructing the template document since using XML for constructing the form 401, which is equivalent to the template document, motivates using SIML for constructing the template document since SIML is an expanded form of XML.

Regarding claims 27 and 30, which are dependent on claim 23, Pennell discloses if the template document and the control document are independent from one another, the detecting step includes recognizing the control document by parsing the template document (figure 7).

Claims 7-12, 14-15 are for an apparatus for performing method claims 23-28, 30-31, and are rejected under the same rationale.

Allowable Subject Matter

11.   Claims 13, 16, 29 and 32 are objected to as being dependent upon a rejected

base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.

Response to Arguments

12.   Applicant's arguments with respect to claims 1-33 have been considered but are

moot in view of the new ground(s) of rejection.

Applicants argue that the data entry according to Pennell fails to create a multimedia

document.

Examiner agrees. Gonzales, in combination with Pennell, discloses that data entered

into a field of a template can be images and text ([0181], figures 6 and 10). Creating a

document by entering data into fields of a template as in Pennell and Gonzales, where

data is text and images, thus, is creating a multimedia document.

Applicants argue that the data entry in Pennell does not disclose fixing the floating field

as required in the present invention.

Examiner respectfully disagrees. The claim recites "fixing the detected floating field to

be an object designated by the information selected by the user among the list of

selectable objects, when the information selected by the user is received in step (c)"

where step (c) is receiving information selected by a user with respect to the output

control document.

In Pennell, the floating field, which can be changed by a user, is fixed with an item

selected from the pull-down list by a user in the document 401, which is equivalent to

the control document (figures 4-5: for the fields have data in the pull-down list, user has

to select one before using the data in this 401 document to fill the form 100). Pennell,

thus, discloses designating an object by the information selected among the list of

selectable objects by a user, received with respect to the control document. In other

words, fixing the floating field is performed.

The form in Pennell is like the template as claimed. Thus, of course, it is reset to be

blank once the website exited. It is only a tool for creating a document by filling data

from document 401. And fixing the fields in Pennell occurs at document 401, which is

equivalent to the control document, not at the form as argued.

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Maxwell et al. (US Pat App Pub No 2003/0188262, priority 10/29/99).

McIntyre (US Pat App Pub No 2004/0054659, filed 9/13/02).

Balkus et al. (US Pat App Pub No 2004/0268224, priority 3/31/00).

Deere (US Pat App Pub No 2005/0196074, priority 3/23/00).

Shimizu et al. (US Pat No 6,374,271, filed 9/26/97).

Kiyono et al. (US Pat No 6,137,483, filed 11/27/96).

14.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-

4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Cong-Lac Huynh
Primary Examiner
Art Unit 2178
05/25/06